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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,605	07/03/2003	David DeRogatis	RAILWA 3.0-001	7300

26291 7590 12/17/2004

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EXAMINER

GARCIA, ERNESTO

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/613,605

Applicant(s)

DEROGATIS ET AL.

Examiner

Ernesto Garcia

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,6-8,10-18 and 21-48 is/are pending in the application.
- 4a) Of the above claim(s) 6,12,14-18 and 21-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,7,8,10,11 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/4/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election and Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 3, 6-8, 10-17 and 29-34, drawn to a plug fastener, classified in class 403, subclass 187.
- II. Claims 18, 21-24 and 26-28, drawn to a method of affixing a picket or a plurality of pickets or a method of affixing pickets at an angle to a first rail and to a second rail, classified in class 256, subclass 22.
- III. Claims 25, 35-45, drawn to a railing, fences, fencing components, or a railing or fencing kit, classified in class 256, subclass 22.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In the instant case, the method of affixing a picket or pickets can be practice with another plug fastener that does not require the particulars of the plug fastener.

Inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require plug fastener. The subcombination has separate utility such as coaxially connecting rods.

Inventions II and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the railing or fences can be made using bolts.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Furthermore, this application contains claims directed to the following patentably distinct species of the plug fastener:

- | | | |
|---------------|---------------------|-----------------------|
| I. Figs. 1-4; | II. Figs. 9 and 10; | III. Figs. 11 and 12; |
|---------------|---------------------|-----------------------|

- IV. Figs. 13A and 13B; V. Figs. 14A and 14B;
VI. Figs 15A, 16 and 17; VII. Figure 15B (note: this figure is not a cross
section of Fig. 15A as there is no flat surface 218 and opening 216 is not square;
VIII. Figs. 18A-18F.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 appears to be generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Art Unit: 3679

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Ms. Diana Rea on December 1, 2004, a provisional election was made with traverse to prosecute the invention of Group I, claims 1, 3, 7, 8, 10, 11 and 13 and species VI. Applicant in replying to this Office action must make affirmation of this election. Claims 6, 12, 14-18, 21-34 and 35-48 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Regarding claim 6, the first engaging surface does have a shape being rectangular, pentagonal, hexagonal, octagonal or other regular polygons having at least four sides. Regarding claim 12, this claim does not read on the elected species as the mating surface does not have threads. Regarding claims 14 and 29, these claims do not read on the elected species as the mating surface is not flat but ball-shaped. Regarding claims 15 and 16, these claims inherently become withdrawn since claim 14 is withdrawn. Regarding claims 30-34, these claims inherently become withdrawn since claim 29 is withdrawn. Regarding claim 17, the elected species, Figure 15A, does not have a cylindrical member.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "200" has been used to designate both a plug fastener with a square opening (Fig. 15A) and a plug fastener with a tapered opening (Fig. 15B).

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "216" has been used to designate both a square opening (Fig. 15A) and a tapered opening (Fig. 15B).

The drawings are objected to because reference character 218 in Fig. 15B does not point to a flat surface but rather an edge of opening 216. Furthermore, the cross section of Figure 15A needs to be correctly illustrated. Hatching needs to be shown in Figure 15B and where the cross section was taken from.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended". If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: "the mating surface includes a plurality of ridges" as indicated in line 2 of claim 11.

The disclosure is objected to because of the following informalities: the detailed description of Figures 15A and 15B fails to specifically state which feature is the first engaging surface and the mating surface as indicated in claim 1. Furthermore, page 8 paragraph 31 states Fig. 15, which does not exist in the drawings. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3, 7, 8, 10, 11 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the limitation "maximum" is a relative term that is not defined by the claims. Maximum to what does the diameter compare to.

Regarding claims 3, 7, 8, 10, 11 and 13, the claims depend from claim 1 and therefore are indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 7, 8, 10, 11 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Rapata, 3,539,234 (see marked-up attachment).

Regarding claim 1, Rapata discloses, in Figure 16, a plug fastener comprising a first engaging surface **A1** and a mating surface **A3**. The first engaging surface **A1** has a maximum diameter **A2**. Applicant is reminded that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Therefore, the maximum diameter **A2** can be adapted to engage an interior surface of an opening in a picket and the mating surface **A3** can be adapted to mate with a second article.

Regarding claim 3, Applicant is reminded that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*,

Art Unit: 3679

69 USPQ 138. Therefore, the plug fastener can be adapted to affix a picket at an acute angle or a right angle to a second article.

Regarding claim 7, the first engaging surface **A1** includes ridges **14h**. Applicant is reminded that the ridges **14h** can be adapted to frictionally engage an opening in a picket.

Regarding claim 8, the first engaging surface **A1** has a shape selected from a group consisting cylindrical, ellipsoidal, conical, elliptic conical frustum, pyramidal frustum, and ball.

Regarding claim 10, the mating surface **A3** can be adapted to engage an interior surface of an opening in a second article.

Regarding claim 11, the mating surface **A3** includes ridges **14h**. Applicant is reminded that the ridges **14h** can be adapted to frictionally engage an opening in a second article.

Regarding claim 13, the mating surface **A3** has a shape selected from a group consisting of cylindrical, ellipsoidal, conical, elliptic, conical frustum, pyramidal frustum, and ball.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 703-308-8606. The examiner can normally be reached from 9:30-6:00. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



E.G.

December 2, 2004

Attachment: one marked-up copy of Rapata, 3,539,234.



DANIEL P. STODOLA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

(Rapata) 3,539,234

